

43. (New) An outer shoe as claimed in claim 42, wherein a thickness of the bottom sole tapers from a greater thickness measured at each said protrusion to a lesser thickness at a location on one side of each said protrusion, as viewed in a horizontal plane when the bottom sole is upright and in an unloaded condition.

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44. (New) An outer shoe as claimed in claim 43, wherein the thickness of the bottom sole tapers to a lesser thickness on both sides of each said protrusion, as viewed in a horizontal plane when the bottom sole is upright and in an unloaded condition.

REMARKS

This amendment is responsive to the Office action dated April 11, 2001, in the above-identified application.

The specification has been amended in order to contain a specific reference to the prior provisional applications from which this application is a continuation pursuant to 35 U.S.C. § 119(e) in compliance with 37 C.F.R. § 1.78.

The drawings were objected to under 37 C.F.R. § 1.83(a) on the basis that they did not show every feature of the invention specified in the claims. Accordingly, Applicant submits herewith a new Fig. 11Q which schematically represents the releasable connection between the removable midsole insert 145 and the bottom sole 149 by mechanical fasteners 301, adhesive 302, snap fit 303 or combinations thereof.

Since this schematic representation does not show a particular location of any of these elements, it does not introduce new matter to the specification. There is sufficient basis in the original specification and claims, as filed, for a releasable connection between removable midsole insert 145 and bottom sole 149 via all of these connecting means. Favorable consideration and approval of new Fig. 11Q is respectfully requested.

Claim 6 has been canceled in order to obviate the objection to the drawings on the basis that the "microcomputer in communication with..." is not shown. Favorable consideration and withdrawal of this objection is requested.

The applicant has been requested to modify the specification under the provisions of MPEP § 1302.01 to restrict the descriptive matter and figures so as to be in harmony with the claims. The applicant wishes to defer modification of the specification until allowable claims have been indicated.

The specification has been objected to under 37 C.F.R. 1.71 for, "...failing to provide a sufficient written description and an enabling disclosure for a removable midsole orthotic [sic] insert which forms at least a portion of the rounded surface to support the embodiment of claim 3." Although the applicant does not agree with this objection, claim 3 has been canceled without prejudice to resubmission thereby obviating this objection.

Claims 1-10 have been rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. More specifically, claims 1-4 and 7 were

rejected on the basis that these claims contain the word, "non-orthotic" which renders the claim vague and indefinite. This rejection is traversed and reconsideration is requested for the reasons, which follow.

More specifically, the term, "non-orthotic" is clearly defined in the specification at page 20, lines 10-12. This definition is sufficient for a person of ordinary skill in the art to be able to determine whether a particular removable midsole or midsole portion is non-orthotic.

Moreover, it is not relevant that the Examiner cannot associate any particular structure with this limitation. This is a functional limitation not a structural limitation. The proper test for whether this limitation meets the requirements of 35 U.S.C. § 112, second paragraph, is whether a person of ordinary skill in the art can determine, for a particular shoe, whether it is non-orthotic. This is a routine matter for the skilled person since he need only apply the definition of the term "non-orthotic" given in the specification. Thus, the term "non-orthotic" meets the requirements of 35 U.S.C. § 112, second paragraph. Accordingly, favorable consideration and withdrawal of the rejection is requested.

Claim 1 has been rejected as indefinite on the basis that the upper does not, "...envelopes [sic] on the outside..." the midsole. Although the applicant does not agree with this rejection, claim 1 has been canceled without prejudice to resubmission thereby obviating the rejection. Accordingly, favorable consideration and withdrawal of the rejection is requested.

Claim 1 has been rejected as indefinite on the basis that the phrase, "...relative to an intended wearer's foot location inside the shoe" at line 9 of claim 1 is indefinite. Although the applicant does not agree with this rejection, claim 1 has been canceled without prejudice to resubmission thereby obviating the rejection. The newly-submitted claims use the terminology, "...relative to a[n inner] section of the removable midsole insert adjacent to the concavely rounded [inner or outer] surface portion." It is considered that the new terminology is sufficiently definite to meet the requirements of 35 U.S.C. § 112, second paragraph. Accordingly, favorable consideration and withdrawal of the rejection is requested.

Claim 3 has been rejected under 35 U.S.C. § 112, second paragraph for several reasons. Although the applicant does not agree with these rejections, claim 3 has been canceled without prejudice to resubmission thereby obviating these rejections.

Claims 1-3 have been rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. patent no. 6,023,857 (Vizy et al.). Claims 1-3 have been canceled without prejudice to resubmission thereby obviating this rejection.

Claims 1-4 have been rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. patent no. 4,845,863 (Yung-Mao). Claims 1-4 have been canceled without prejudice to resubmission thereby obviating this rejection.

Claims 1-4 have been rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. patent no. 597,524 (Molloy). Claims 1-4 have been canceled without prejudice to resubmission thereby obviating this rejection.

Claims 1-4 have been rejected under 35 U.S.C. § 103(a) as being obvious over WO 94/03080 (Ellis '080) in view of Vizy or Yung-Mao. Claims 1-4 have been canceled without prejudice to resubmission thereby obviating this rejection.

Claims 5-10 have been rejected under 35 U.S.C. § 103(a) as being obvious over WO 94/03080 (Ellis '080) in view of Vizy or Yung-Mao and further in view of U.S. patent no. 5,813,142 (Demon). Claims 5-10 have been canceled without prejudice to resubmission thereby obviating this rejection.

New claims 11-24 are considered to be novel and unobvious over the cited prior art since the cited prior art does not teach or suggest the provision of a removable midsole section which includes a secondary outer sole such that it can be worn separately from the shoe.

New claims 25-44 are considered to be patentable over the cited art since the cited art does not teach or suggest the use of a plurality of protrusions having concavely rounded outer surface portions and being located on a side of a removable midsole section to releasably retain the removable midsole section inside of a shoe.

Claims 1-10 have been provisionally rejected under 35 U.S.C. § 101 as claiming the same invention as that of claims 11-44 of co-pending U.S. application no. 09/375,480. This rejection is traversed and reconsideration is requested for the reason, which follows.

More specifically, all claims of the present application relate to a non-orthotic removable midsole section whereas all claims of co-pending U.S. application no.

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09/375,480 relate to an insertable midsole orthotic. The terms, "non-orthotic" and "orthotic" are defined in the respective applications. A careful review of these definitions demonstrates that the definitions of these terms are mutually exclusive. In other words, if an insert is orthotic, it cannot also be non-orthotic, and if an insert is non-orthotic, it cannot also be orthotic. Accordingly, the claims of the present application do not relate to identical subject matter as the claims of co-pending U.S. application no. 09/375,480 since the terms "orthotic" and "non-orthotic" are mutually exclusive. Favorable consideration and withdrawal of the rejection is requested.

Claims 1-10 have been rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 11-44 of U.S. patent application no. 09/358,848. This rejection is respectfully traversed on the basis that no claims have yet issued from U.S. patent application no. 09/358,848 which is still a co-pending application and thus a rejection under the judicially created doctrine of obviousness-type double patenting is premature. This rejection should have been presented as a provisional rejection and the applicant will address this rejection once the claims of one of the present application and co-pending application no. 09/358,848 have issued.

The applicant would like to bring to the Examiner's attention that in addition to co-pending application no. 09/375,480, other U.S. applications with the same inventor have been filed and are co-pending, including U.S. application serial nos. 09/358,848 and 09/558,629.

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Favorable consideration and issuance of a Notice of Allowance are respectfully requested.

Respectfully submitted,

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Redline Version Showing Amendments to Specification

IN THE SPECIFICATION

Page 23, entire page

| | |
|------|--|
| 120 | pressure sensing circuitry |
| 121 | main longitudinal arch (long arch) |
| 122 | flexibility axis |
| 123 | flexible connecting top layer of sipes |
| 124 | flexibility axis |
| 125 | base of the calcaneus (heel) |
| 126 | metatarsal heads (forefoot) |
| 129 | honeycombed portion |
| 145 | non-orthotic removable midsole section |
| 147 | upper midsole (upper areas of shoe midsole) |
| 148 | midsole |
| 149 | bottom sole |
| 150 | compression force |
| 151 | channels with parallel side walls |
| 155a | tension force along the top surface of the shoe sole |
| 155b | mirror image of tension force 155a |
| 158 | subcalcaneal fat pad |
| 159 | calcaneus |
| 160 | bottom sole of the foot |
| 161 | cushioning compartment |
| 162 | natural crease or upward taper |
| 163 | crease or taper in the human foot |
| 164 | chambers of matrix of elastic fibrous connective tissue |
| 165 | lower surface of the upper midsole |
| 166 | upper surface of the bottom sole |
| 167 | outer surface of the support structures of the foot |
| 168 | upper surface of the foot's bottom sole |
| 169 | shank |
| 170 | flexible material filling channels (sipes) |
| 176 | <u>protrusions</u> |
| 177 | <u>recesses</u> |
| 180 | mini-chambers |
| 181 | internal deformation slits (sipes) in the sagittal plane |
| 182 | internal deformation slits (sipes) in the horizontal plane |
| 184 | encapsulating outer midsole section |

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| 185 | midsole sides |
| 187 | upper midsole section |
| 188 | encapsulated midsole section or bladder |
| 189 | central wall |
| 191 | fibrous capsule shell |
| 192 | subdivided cushioning compartments |
| 201 | horizontal line through lower most point of upper surface of the shoe sole |
| 206 | fluid duct |
| 210 | fluid valve |
| 300 | control system |
| <u>301</u> | <u>mechanical fasteners</u> |
| <u>302</u> | <u>adhesive</u> |
| <u>303</u> | <u>snap fit</u> |

Page 46, lines 12-21 of the specification.

--Once the bottom sole 149 is attached, the removable midsole section 145 may then be inserted into the interior cavity of the upper 21 and affixed to the top side of the bottom sole 149, as shown in Fig. 75C. The midsole section 145 can be releasably secured in place by any suitable method including mechanical fasteners 301, adhesives 302, snap-fit arrangements 303, reclosable compartments, interlocking geometry's 176, 177, and other similar structures. To provide interlocking geometries, the removable midsole section 145 preferably includes protrusions 176 placed in an abutting relationship with the bottom sole 149 so that the protrusions 176 occupy corresponding recesses 177 in the bottom sole 149.--